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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/777,476	02/06/2001	Edward M. Housel	MBHB00-1197	8882

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EXAMINER
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TRAN, DOUGLAS Q

ART UNIT	PAPER NUMBER
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2624

DATE MAILED: 07/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/777,476

Applicant(s)

HOUSEL, EDWARD M.

Examiner

Douglas Q. Tran

Art Unit

2624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 5-19 is/are rejected.
- 7) ☒ Claim(s) 4 and 19 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 4.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_.

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-3, 5-18 are rejected under 35 U.S.C. 102(e) as being anticipated by Roberts et al. (US Patent No. 6,650,431).

As to claim 1, Roberts teaches a process for printing mixed color and black/white print jobs comprising the steps of:

entering a print job (400 in fig. 4) in machine readable form (200 in fig. 2);

processing the print job to identify the pages within the job containing color (col. 6, lines 58-60);

creating and storing a first digital file (402 in fig. 4) of the pages containing color;

creating and storing a second digital file (404 in fig. 4) of the pages that are only black and white,

(it is noted that pages from the print job would be inherently formed onto a file before being transmitted to the printer for printing, because the printer just receives the formed file including at least one page for processing to print);

Art Unit: 2624

creating and storing additional digital file containing the feature of the print job including the location of the color pages (col. 8, lines 55-58: the additional pages include the page ordering information would be considered as an additional digital file);

printing the color pages stored in the first digital file on a color printer (col. 6, lines 61-62; since the page 10 is color page, the color page 10 is transmitted to the color printer for printing, thus, the color page 10 would be in the file form including only one color page);

setting up a digital printer so it can access the printed color pages; and running the print job on the digital printer including merging the color pages into the black/white pages to result in a merged document (col. 7, lines 15-25 and fig. 7),

(it is noted that a digital printer, which is claimed without the printing function for black and white pages of the print job, would be considered as a merge station 114 in fig. 1 because the merge station 114 that has the same claimed functions of the claimed digital printer).

As to claim 2, Roberts disclose every feature discussed in claim 1, and further teaches of the operator is able to manually force color or black/white printing on a given page of the print job (col. 12, lines 42-44).

As to claim 3, Roberts discloses every feature discussed in claim 1, and further teaches the identification of the pages within the print job that contain color is performed by analyzing the pixels to determine whether the percentage of cyan, magenta and yellow pixels exceed a threshold level, wherein pages that exceed the threshold level are identified as containing color and those that do not are forced to black and white (fig. 3 and 5).

Art Unit: 2624

As to claim 5, Roberts discloses every feature discussed in claim 1, and further teaches the step of setting up a digital printer so it can access the printed color pages comprises placing the printed color pages in an input tray of the digital printer (either 706 or 708 in fig. 7).

As to claim 6, Roberts discloses every feature discussed in claim 1, and further teaches the pages in first digital file and second digital file are stored in rasterized form (402 and 404 in fig. 4).

As to claim 7, Roberts discloses every feature discussed in claim 1, and further teaches the processing, creating and storing steps are performed by a raster imaging processor (108 in fig. 2).

As to claim 8, Roberts discloses every feature discussed in claim 1, and further teaches the step of printing an operator instruction sheet (col. 8, lines 57-58).

As to claim 9, Roberts disclose every feature discussed in claim 8, and further teaches the operator instruction sheet is printed before the color pages are printed (col. 8, lines 57-58).

As to claim 10, Roberts teaches a process for printing mixed color and black/white print jobs comprising the steps of:

entering a print job in machine readable form (i.e., PDL format; col. 7, lines 57-64), the print job including pages with color and pages only in black and white (col. 8, lines 27-34; and 402, 404 in fig. 4);

printing the pages with color on a color printer (col. 6, lines 61-62);

setting up a digital printer so it can access the printed color pages; and running the print job on the digital printer including merging the color pages into the black/white pages to result in a merged document (col. 7, lines 15-25 and fig. 7),

Art Unit: 2624

(it is noted that a digital printer, which is claimed without the printing function for black and white pages of the print job, would be considered as a merge station 114 in fig. 1 because the merge station 114 that has the same claimed functions of the claimed digital printer).

As to claim 11, Roberts discloses every feature discussed in claim 10, and further teaches the step of setting up a digital printer so it can access the printed color pages comprises placing the printed color pages in an input tray of the digital printer (either 706 or 708 in fig. 7).

As to claim 12, Roberts discloses every feature discussed in claim 10, and further teaches the pages in first digital file and second digital file are stored in rasterized form (402 and 404 in fig. 4).

As to claim 13, Roberts discloses every feature discussed in claim 10, and further teaches the step of printing an operator instruction sheet (col. 8, lines 57-58).

As to claim 14, Roberts disclose every feature discussed in claim 8, and further teaches the operator instruction sheet is printed before the color pages are printed (col. 8, lines 57-58).

As to claim 15, Roberts teaches the apparatus claim for performing the method claim 10 as indicated above.

As to claim 16, Roberts discloses every feature discussed in claim 15, and further teaches the processor is a raster imaging processor (108 in fig. 2).

As to claim 17, Roberts teaches the digital printer is a high speed digital printer (col. 7, lines 20-23).

As to claim 18, Roberts discloses every feature discussed in claim 16, and further teaches the data processor counts cyan, magenta and yellow pixels in each page of the print job to

Art Unit: 2624

determines whether there is color on the page, the determination is based on whether the number of pixels exceeds a threshold level (fig. 3 and 5).

***Allowable Subject Matter***

3. Claims 4 and 19 are objected.

Claims 4 and 19 are objected to as being dependent upon a rejected base claims 1 and 15 respectively, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

As to claims 4 and 19, the prior art, taken either singly or in combination, does not teach: "the threshold level is set at 2% of either cyan, magenta or yellow pixels and 1% of the combination of all three".

***Examiner's Remark***

Owa et al. (US Patent No. 6,348,971 B2), Kato (US Patent No. 6,760,120 B2) and Sumio et al. (US Patent No. 6,311,029 B1) which similarly disclose the features to the teaching of Roberts and some of the addressed limitations of the claims.

***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Douglas Q. Tran whose telephone number is (703) 305-4857 or E-mail address is Douglas.tran@uspto.gov.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-4700.

Douglas Q. Tran  
July 20, 2004

